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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,357	06/26/2007	Alex Hogg	DEP5246USPCT	9482
27777	7590	09/02/2009	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			LAWSON, MATTHEW JAMES	
			ART UNIT	PAPER NUMBER
			3775	
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			09/02/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/584,357

## Applicant(s)

HOGG ET AL.

## Examiner

MATTHEW LAWSON

## Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 6/21/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10, drawn to a reamer guide.

Group II, claim(s) 11-13, drawn to a method of reaming.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The corresponding technical feature is a reaming guide having a bushing as shown in claims 1 and 11. These claims lack unity *a posteriori*, with respect to figure 1 of Umber et al. (US 5,827,288).

3. During a telephone conversation with Attorney Brian Tomko on August 11<sup>th</sup>, 2009 a provisional election was made **without** traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Information Disclosure Statement***

4. The information disclosure statement filed June 21<sup>st</sup>, 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it lacks the publication or

filing date for all of the cited pieces of art. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Claim Objections***

5. Claim 10 is objected to because of the following informalities: Claim 10 is dependent upon "any one of claims 7". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Umber et al. (US 5,827,288).

Regarding claims 1-6, Umber et al. disclose a reamer guide for reaming a cavity within a tibia, the reamer guide comprising a plate (15, figure 1) having a circular aperture (17, figure 2) therethrough and defining a plane (figure 2), and a disc (43,

figure 2) rotatably mounted in the aperture, the disc having a bushing (49, figure 2) therein defining a reamer axis (13, figure 1) offset from the center of the disc for receiving a reamer (71, figure 3) in use and in which the disc is capable of rotation about an axis transverse to the plane of the plate (column 3, lines 31-37), and the plate further includes at least one mounting hole (25, figure 2), wherein the plate further comprises an inner circular edge (see figure below) having a first formation (see figure below) therein, and wherein the periphery of the disc has a matching formation (see figure below) that engages with the first formation to retain the disc within the aperture. The circular formation is a shoulder (see figure below) and the matching formation is a flange (see figure below), wherein the reamer axis (13, figure 1) is angled toward the axis of rotation (figures 1-2, 4, and column 2, lines 49-51). The bushing further has a free end (top surface, see figure below) and includes a stop (top surface acts as a stop when the reamer contacts the surface, see figure below) located toward a free end for limiting travel of a reamer into the bushing.

8. Regarding claims 7-8, and 10 Umber et al. disclose a reamer guide (figures 1-2, and 4) for reaming a cavity within a tibia, the reamer guide including a plate (15, figures 1-2, 4) having a circular aperture (17, figure 1) therethrough and defining a plane (figure 1) and a disc (43, figure 2) rotatable mounted in the aperture, the disc having a bushing (49, figure 2) therein defining a reamer axis (13, figure 1) from the center of the disc for receiving a reamer (71, figure 3) and in which the disc is capable of rotation about an axis transverse to the plane of the plate, the bushing having an inner diameter

(opening/diameter of the bushing 49, figure 2 and 4) and a reamer (71, figure 3) sized to substantially match the inner diameter of the bushing. The reamer further includes a projection (see figure below) and is sized to engage with an edge of a free end of the bushing, the projection positioned a distance from a distal end of the reamer to control the depth of the cavity to be formed to correspond to a desired depth (acts as a stop member); the assembly further comprises a drive mechanism (69, figure 3) attached to the joint for rotating the reamer.

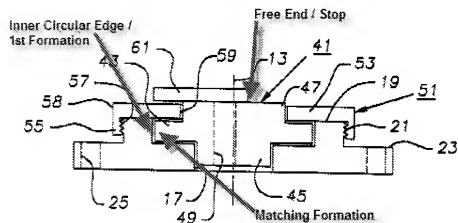


Fig. 2

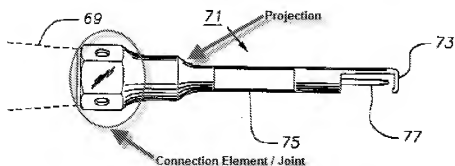


Fig. 3

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Umber et al. (US 5,827,288) in view of McCleary et al. (EP 1 348 384 A2).

Umber et al. disclose the claimed invention except for the connection mechanism being a universal joint attached to the reamer for transmitting torque.

McCleary et al. disclose the connection mechanism being a universal joint (28, figure 1) attached to the reamer (28, figure 2, ¶27) for transmitting torque (¶26-27, 29-35) to permit the rotary motion device (drive shaft) while permitting the reamer to be positioned in various angular orientations (¶31). Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the connection device of Umber et al. for the universal joint of McCleary et al. to permit the rotary motion device while permitting the reamer to be positioned in various angular orientations.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **See attached PTO-892.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW LAWSON whose telephone number is (571)270-7375. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. L./  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
Unit 3775